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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,200	08/07/2000	Michael C. Kiefer	4147-7-1DIV4	3491

22442 7590 04/09/2003

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EXAMINER

UNGAR, SUSAN NMN

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 04/09/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,200

Applicant(s)

Kiefer et al

Examiner

Ungar

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jun 13, 2002

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 32-38 and 59-65 is/are pending in the application.

4a) Of the above, claim(s) 33-38, 64, and 65 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 32 and 59-63 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) ☐ Other:

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1. Upon review and reconsideration, the previous Final Office Action is withdrawn.
2. The Amendment filed June 13, 2002 (Paper No. 10) in response to the Office Action of February 3, 2002 (Paper No. 6) is acknowledged and has been entered. Previously pending claim 32 has been amended. Claims 32 and 59-63 are currently being examined.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The Submission of November 25, 2002 (Paper No. 12) is acknowledged and has been entered. In the submission, Applicant states that the references cited in the original 1449 are submitted. However, no references are found in the file. Therefore, Examiner is unable to consider the references or to include a copy of the signed 1449 with this communication.
4. The Submission of February 25, 2003 (Paper No. 13) is acknowledged and has been entered. Applicant's disclosure of the telephone interview and subsequent voice mail messages is correct.
5. The following rejections are maintained:

Claim Rejections - 35 USC § 112

6. Claim 60 remains rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 6, Section 5, page 3.

Applicant argues that the rejection is believed moot pending the withdrawal of the rejection of claims 32 and 59-63 under 35 USC 102(e).

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The argument has been considered but has not been found persuasive because the rejection of claims 32 and 59-63 under 35 USC 102(e) has not been withdrawn for the reasons set forth below.

Claim Rejections - 35 USC § 102

7. Claims 32, 59 and 61-63 remain rejected under 35 USC 102(e), for the reasons previously set forth in Paper No. 6, Section 7, pages 3-4.

Applicant argues that US Patent No. 5,672,686 does not appear to be effective as prior art since the present application has a priority date for SEQ ID Nos 7, 9, 21 and positions 60-211 have a priority date of October 7, 1994 and US Patent No. 5,672,686 was filed on October 11, 1994 which is four days after the instant priority date. Further, US Patent No. 5,672,686 is a continuation-in-part of US Application No. 08/287,427, filed August 9, 1994 and Examiner has not provided any discussion regarding the disclosure of the '686 priority document.

The argument has been considered but has not been found persuasive because it is assumed that, unless otherwise stated, that priority date for the referenced patent is the earliest listed priority date, that is, the priority date of the parent application. Applicant has clearly not provided evidence that the priority of the cited reference is not August 9, 1994, the filing date of the abandoned parent application. It is noted, for Applicant's information, that US Application No. 08/287,427 specifically claims an isolated Bcl-Y protein (claim 1) as well as both monoclonal and polyclonal antibodies to said protein in claims 21-23. The claims are properly rejected under 35 USC 102(e). Applicant's arguments have not been found persuasive and the rejection is maintained.

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Applicant further argues that the present application further claims priority to US Application Serial No. 08/160,067 filed November 30, 1993 for limitations drawn to Cdn-1. The argument has been considered but has not been found persuasive because claims drawn to antibody to Cdn-1 are not rejected under 35 USC 102(e). Applicant's arguments have not been found persuasive and the rejection is maintained.

Applicant further argues that the present application further claims priority to US Application Serial No. 08/160,067 filed November 30, 1993 for limitations drawn to Cdn-1 and that antibodies to Cdn-1 should also be equated with antibodies that bind to any of SEQ ID Nos 9, 21 since these sequences are highly similar to SEQ ID NO:7 and since antibodies to SEQ ID NO:7 were found to be free of the art due to the priority date of the 08/160,067 filed November 30, 1993 then 08/160,067 logically provides a disclosure sufficient to retain the benefit of priority for the claimed invention and the '686 patent is not effective prior art against the claimed invention.

The argument has been considered but has not been found persuasive because neither SEQ ID NO:9 nor SEQ ID NO:21 were described or contemplated in the 08/160,067 application and there is no support therein for claiming antibodies to SEQ ID NO:9 or SEQ ID NO:21. The instant application is only entitled to the benefit of the filing date of the parent application if they both contain common subject matter. Clearly, the parent application and the instant application do not contain common subject matter drawn to SEQ ID NO:9 and SEQ ID NO:21. The claims are properly rejected under 35 USC 102(e) for the reasons of record.

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Applicant's arguments have not been found persuasive and the rejection is maintained.

8. All other objections and rejections recited in Paper No. 6 are withdrawn.
9. No claims allowed.
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

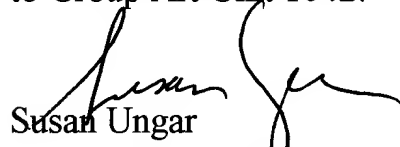
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.



Susan Ungar
Primary Patent Examiner
March 26, 2003